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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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02/481-102 11/12/00 HAWKE

0619/000001

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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<i>1-3-01</i>
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<i>6-3-01</i>
<i>5/1</i>

Rd

Office Action Summary

Application No.

09/441,152

Applicant(s)

Quake et al

Examiner

Evelyn Lester

Group Art Unit

2873



☐ Responsive to communication(s) filed on _____

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 8, 9, and 12 is/are allowed.

☒ Claim(s) 1-7, 10, 11, and 13-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112 and/or 35 U.S.C. 101

1. Claim 1 provides for the use of the lens optical properties, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1 and 2, the disclosure is insufficient to cover all possible and future properties of the claimed invention wherein the limitation recites just "optical properties" and "optical altering properties."

With respect to claim 17, the claimed invention is attached to "a surface," however, there is no evidence in the disclosure that the Applicants were in possession of every possible "surface" that the lens can be attached to. Therefore, this claim also has undue breath for which there appears to be no support in the disclosure.

3. Claims 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for biochemical glue, does not reasonably provide enablement for "chemical methods" and biochemical methods (in general). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The disclosure only mentions the biochemical glue as a means for attaching, but goes no further in describing any other methods of attaching. Therefore, claim 18 has no enablement in the disclosure.

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Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-7, 10, 11 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 2-7, the preamble recites a "device" but there is no device in claim 1, from which these claims depend.

With respect to claim 2, there is no antecedent basis for "said altering optical properties."

With respect to claim 3, there is no antecedent basis for "said structure."

With respect to claim 4, repeat recitation to the sphericity of the lens is confusing.

With respect to claim 7, "consisting of" is closed claim language and can not be paired with open ended limitations such as "multiple lens elements." Suggest changing to ---comprising---.

With respect to claim 10, it is unclear what is meant by "a different optical characteristic."

With respect to claim 11, there is no antecedent basis for "said different optical characteristic."

With respect to claim 17, there is no antecedent basis for "said latex."

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Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Commercially available latex microspheres, as disclosed on page 2 of the specification, first paragraph of invention summary.

Because the microspheres of the prior art have the same physical composition, it must have the same properties, and the claiming of a new use, new function or unknown property which is inherently present in the prior art is not patentable when the prior art product seems to be identical, even when the prior art is silent to the inherent characteristic(s).

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6. Claims 1-7 and 13-22, as far as respective claims are understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japanese Patent Publication (JP-08-001810 A).

Please note that the English Abstract was only available on the JPO-ABS data base. However, the abstract more than discloses the claimed invention of spherical lens having a diameter of less than 10 microns.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Allowable Subject Matter

7. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 8, 9 and 12 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not appear to teach and/or suggest the sensor device of the above claims, including the combination of claimed elements and claimed limitations.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E.A. Lester whose telephone number is (703) 308-4943. The examiner can normally be reached on Monday-Friday (except for first Fridays of a biweek) from about 8:30 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on (703) 308-4883. The fax number for Technology Center 2800 is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Evelyn A. Lester
Patent Examiner
AU 2873
January 2, 2001